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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,977	05/10/2001	Takahiro Koga	01USFP641-m.k.	4106

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER	
KRAMER, JAMES A	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,977	KOGA, TAKAHIRO	
	Examiner	Art Unit	
	James A. Kramer	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 11-17 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Iinuma et al. in view of Admitted Prior Art

Iinuma et al. teaches an information network system in which user terminals include broadcasting signal reception sections for receiving a broadcasting signal transmitted by wireless or by a cable from the broadcasting center (column 5; lines 14-17). Iinuma et al. teaches the broadcasting signal includes a commercial program (i.e. advertisement) (column 5; line 54).

Starting at column 9; line 11, Iinuma et al. describes a case wherein, a user watches a shopping program at the user terminal and makes an application for shopping to database center. The user watches an image inserted in the shopping program and manually operates a running key on a remote control (column 9; lines 34-37). The CPU thus forwards a call origination instruction which connects the user terminal to the network (column 10; lines 7-11) wherein guide information and user information are transmitted to a sub computer (column 10; lines 11-14). Examiner notes that this represents informing said selection to a service system through network with user ID.

Examiner next references figures 10a-10c which represents an example of the screen of communication information presented to the user. This information represents the preparing and

display of a private page of detail information by which a user is able to carry out the purchase of the product. Examiner also notes that the data on this page, is derived from customer data (Figure 10(b)) and policy data (Figure 10(c)).

Iinuma et al. does not specifically teach how or who produces the shopping program (i.e. advertisement). Applicants own admitts in Figure 1 and on pages 1 and 2 of the specification that it is prior art for an advertiser to request an advertising agency to advertise articles and for the advertising agency to produce an advertisement program, then transmit the produced advertisement program to the broadcasting station and finally, request the broadcasting of the advertisement program.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the shopping program of Iinuma et al. is produced by an advertising agent in response to a demand from an advertiser as is old and well known in the art. One of ordinary skill at the time of the invention would be motivated to combine the references as taught in order for an advertiser to leverage the skills and resources of an advertising agent when marketing a product.

Iinuma et al. does note specifically teach paying an advertising production fee, paying a broadcasting fee or charging a fee for every transaction. The common knowledge or well-known in the art statement made by the Examiner in the Office Action mailed 2/13/04 is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate (MPEP2144.03(C)). As such it is admitted as Prior Art that all three of the above mentioned fees are old and well know in the business methods art. It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the system of Iinuma et al. by incorporating all three of the previously mentioned fees in order to specifically illustrate how the system generates profits for the advertising agent, broadcaster and service system. (Examiner notes that Applicant's traversal of Offical Notice does note mention these fees and as such does not traverse the Official Notice of these fees).

Claims 9-10 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iinuma et al. as applied to claims 1-8, 11-17 and 20 above, and further in view of Rioedan et al. Iinuma et al. does not teach producing marketing data based on purchases made and transmitting the marketing data to advertiser in order to optimize policy data.

Rioedan et al. teaches (in the background) that market research is an important business tool which permits companies to cost-effectively target their marketing and sales activities and efficiently reach potential customers. Rioedan et al. further teaches that organizations have long been known to collect marketing data by tracking sales transaction. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Iinuma et al. to collect purchasing data and to send this data to the advertiser in order to more cost effectively target marketing and sales activities (i.e. optimize policy data).

Response to Arguments

Applicant's arguments filed 4/26/04 have been fully considered but they are not persuasive. Applicant asserts that Iinuma does not anticipate Applicant's claimed invention, however Applicant does not addresses the invention as claimed but rather the Applicant as disclosed in the Specification. For example, Applicant states that Iinuma does not concern the provision of custom-selected advertising. Applicant goes on to describe an embodiment with the

use of the interaction of multiple systems to generate customer-selected presentation of advertising to a user. Unfortunately, this is not part of the ***claimed*** invention.

Examiner points to MPEP 2111: "The court explained that 'reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim'".

In this case Applicant is reading limitations of the specification into the claims. Examiner believes that the rejection as presented properly rejects Applicant's ***claimed*** invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Examiner references 2144.03(D) in support of finality of this Office Action. Specifically, Examiner notes that if a reference is added in an Office Action only as directly corresponding evidence to support a prior common knowledge finding, the Office Action may be made final.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

JAK